UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,024	06/11/2001	Philip S. Coulthard	CA920010014US1/2182P	3395

7590 08/23/2005

Sawyer Law Group LLP
P.O. Box 51418
Palo Alto, CA 94303

EXAMINER	
STORK, KYLE R	
ART UNIT	**PAPER NUMBER**
2178	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/879,024	COULTHARD ET AL.	
	Examiner	Art Unit	
	Kyle R. Stork	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This final office action is in response to the amendment filed 27 June 2005.

2. Claims 1-16 are pending. Claims 14-16 are new claims. Claims 1 and 10-13 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's amendments add the limitations of "source code of a non-web enabled application on a server to a network interactive web-browser page, (claim 1, lines 1-2)." However, source code of a non-web enabled application on a server is not disclosed within the applicant's specification.

Similar subject mater is used in independent claims 10-13. Claims 2-9 and 14-16 are rejected for their dependence upon rejected base claims.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "source code of a non-web enabled application on a server to a network interactive web-browser page" in claims 1 and 10-13 is used by the claim to mean a non-web enabled file, while it is well known that text files may be displayed within a browser. The term is indefinite because the specification does not clearly redefine the term. For the purpose of examination, a non-web enabled document will be considered to be a document, which is not displayed.

Claims 2-9 and 14-16 are rejected for their dependence upon rejected base claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

> granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-5 and 8-13 remain rejected under 35 U.S.C. 102(e) as being anticipated by Alexander (USPN 6,732,331 B1—filing date 2/15/2000).

Regarding independent claim 1, Alexander discloses a method for converting display source code of a non-web enabled application on a server to a network interactive web-browser page (see col. 4, lines 15-40, the invention is a Web server application that services requests for Web pages), said method comprising the steps of: (a) resolving the display source code of the non-web enabled application into a plurality of record formats (see col. 4, lines 15-40, this is inherent to processing the HTTP content of the web page; the source code of the non-web enabled application is the template (a template is not displayed in the web browser, but the instructions are applied to data to format the data) containing the formatting instructions for the database data); (b) for each of the plurality of record formats, resolving a plurality of references within the record format to database files (see col. 4, lines 15-40, the web pages may be populated in conjunction with a database); (c) determining the hierarchy and relationships of the plurality of references (see col. 4, lines 15-40, this is inherent to the interpretation of a web page); (d) parsing the plurality of references to a web-language file using nested tags to capture the hierarchy and relationship of the plurality of references to create network user interface pages (see col. 4, lines 15-40, this is inherent to the interpretation of a web page); and (e) converting the network user interface pages to an object-oriented platform-independent network language (see col.

4, lines 15-40, the use of Enterprise JavaBeans implies an object-oriented superstructure) by: (i) creating dynamic components for input, output, and feedback references (see col. 4, lines 15-40, the use of Enterprise JavaBeans implies such dynamic components), and (ii) creating a static component for unchanging references of each record format (see col. 4, lines 15-40, the markup language itself is a static component).

Regarding dependent claim 2, Alexander discloses a method wherein the network interactive web-browser page is displayed on the Internet (this is inherent to the processing of the Web application in col. 4, lines 15-40).

Regarding dependent claim 3, Alexander discloses a method wherein the network interactive web-browser page is displayed on a network selected from the group consisting of: an internal network, an Intranet, a LAN, a WAN, an internal bus, a wireless network (Figure 1, item 14 shows an internal network).

Regarding dependent claim 4, Alexander discloses a method wherein the web-language file is an XML language file (Alexander discloses the use of XML in col. 4, lines 30-35).

Regarding dependent claim 5, Alexander discloses a method wherein the XML language file is an HTML file (Alexander discloses the use of HTML in col. 4, lines 25-35).

Regarding dependent claim 8, Alexander discloses a method wherein the dynamic components further comprise JavaBeans (Alexander discloses the use of JavaBeans in col. 4, lines 30-40).

Regarding dependent claim 9, Alexander discloses a method wherein the network user interface pages are stored on the server (Alexander discloses enhanced server-side functionality in col. 4, lines 30-40).

Regarding independent claim 10, it is a computer readable medium for a program that performs a method similar to that claimed by claim 1, and is rejected under similar rationale.

Regarding independent claim 11, it is a computer readable medium for a program that performs a method similar to that claimed by claim 1, and is rejected under similar rationale.

Regarding independent claim 12, it is a computer system that is a more broadly claimed version of a system that is designed to perform the method of claim 1 and is rejected under similar rationale.

Regarding independent claim 13, it is a computer server that is designed to perform parts of the method of claim 1 and it is rejected under similar rationale.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 6-7 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander, further in view of Zhou et al. (USPAP US 2002/0162093 A1—filing date 4/30/2001, hereinafter Zhou).

Regarding dependent claim 6, Alexander fails to disclose that the XML language file is a WML file. However, Zhou discloses in [0064] that XML and WML are similar types of language which affect localization, so it would have been obvious to one of ordinary skill in the art at the time of the invention to use WML as a type of XML because it would help to localize the XML

Regarding dependent claim 7, Alexander fails to disclose that the static component further comprises a JavaServer Page. However, Zhou discloses in [0064] the use of JavaServer Pages to enhance J2EE functionally. It would have been obvious to one of ordinary skill in the art at the time of the invention to use JavaServer pages in conjunction with Alexander to enhance J2EE functionality.

11. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander, further in view of Alam et al. (US 6336124, filed 7 July 1999, hereafter Alam).

As per dependent claim 14, Alexander discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Alexander fails to specifically disclose the method wherein each of the steps occurs at development time. However, Alam discloses performing steps at development time (Figure 6: Here, during

development of a document, several steps are performed to convert a document in one format to a document in another format).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alexander's method with Alam's method, since it would have allowed a user to output data to a web browser (Alam: column 6, lines 33-49).

As per dependent claim 15, Alexander and Alam disclose the limitations similar to those in claim 14, and the same rejection is incorporated herein. Alam further discloses the method of performing steps offline without a remote connection to a server (Figure 6; column 6, lines 33-49: Here, an intermediate document is generated for an original document. The intermediate document is then acted upon to generate the final output format).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Alexander and Alam's method with Alam's method, since it would have allowed a user to output data to a web browser (Alam: column 6, lines 33-49).

As per dependent claim 16, Alexander discloses the limitations similar to those in claim 10, and the same rejection is incorporated herein. Alexander fails to specifically disclose:

- The program instructions for parsing the display file data description source and converting the network user interface page are each executed during development time of the web-browser page

- The program instructions for dynamically updating the web-browser page and displaying the web-browser page are each executed during runtime

However, Alam discloses:

- The program instructions for parsing the display file data description source and converting the network user interface page are each executed during development time of the web-browser page (Figure 6; column 6, lines 33-49: Here, the display file data description source is processed to form an intermediate document during development time)
- The program instructions for dynamically updating the web-browser page and displaying the web-browser page are each executed during runtime (Figure 6; column 6, lines 33-49: Here, the output format document is generated during runtime)

Response to Arguments

12. Applicant's arguments filed 27 June 2005, with respect to claims 1-13, have been fully considered but they are not persuasive.

The applicant argues that Alexander fails to disclose source code of a non-web enabled application on a server to a network interactive web-browser page. However, as specified above, the applicant does not support this limitation within the specification, and this constitutes new matter. Further, it is unclear to the examiner how a source code file stored on a server to a network interactive web-browser page is non-web enabled. The applicant's arguments are not persuasive.

13. Applicant's arguments with respect to claims 14-16 have been considered but are moot in view of the new ground(s) of rejection.

The Alam reference has been added to address new claims 14-16.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R. Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork
Patent Examiner
Art Unit 2178

krs

CESAR PAULA
PRIMARY EXAMINER